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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,787	05/14/2001	Akihisa Murata	Q64434	7102

7590 02/03/2004

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Washington, DC 20037

EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 02/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 7/14/03

☒ This action is **FINAL**.

- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 2-5 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 2-5 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The Examiner has withdrawn the specific prior art rejection of claims 2-5 of record in view of applicants' brief filed July 14, 2003 in favor of the partially revised rejections set forth below. This is primarily because the Examiner has not specifically relied upon the machine translated entire text of Japanese Patent Abstract -910, which was not initially available to the Examiner and of which the disclosure of the patent Abstract XP -577 is based. Note, however, that this document has earlier been brought to applicants' attention, both in the final rejection and particularly the Advisory Action, Paper No. 10 mailed March 12, 2003. Accordingly, since the rejection set forth below differs little from that previously of record except to utilize the complete translation of JP -910 and also to drop the Gutman et al. reference, U.S. 5,508,107, cited as evidence of the art, which is no longer necessary, the Examiner believes that he ^{is} ~~was~~ justified in making the following rejection FINAL.

3. Claims 1-5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Japanese Patent Abstract -164 or applicants' admissions regarding the prior art on page 1 of the specification taken in view of the complete English translation of JP -910, substantially for the reasons already of record, together with the following additional observations. To

reiterate, JP -164 discloses a thermally releasable pressure sensitive adhesive sheet comprising a thermally expandable microsphere-containing pressure sensitive adhesive layer coated onto a suitable base and which optionally employs a rubber-like organic elastic layer such as applicants claim in their claim 4. Additionally, applicants appear to admit on page 1 of the specification that heat peelable pressure sensitive adhesive sheets can comprise a suitable adhesive coated onto a substrate, the adhesive comprising heat-expandable microspheres and which result in an adhesive sheet that can be easily peeled from the adherend. The primary references each lack a teaching of the claimed surface resistivity performance parameter, i.e., a minimal level of antistatic behavior, and also fail to teach surface roughnesses of the type which applicants now claim. JP -910, however discloses (note, e.g., paragraphs [0004]-[0007], [0032], the Examples) pressure sensitive adhesive compositions which exhibit surface resistivity values when coated onto a suitable backing, i.e. polyester film, of the range which applicants contemplate. Additionally, the reference is suitable for surface protection of electronic parts in elevated temperature operations such as applicants appear to contemplate. With respect to the roughness parameter, note again as evidence of the state of the art U.S. Patent Application Publication -515 to Shibata et al., particularly at page 2, paragraph 12 wherein

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it is taught that pressure sensitive adhesive layers often exhibit surface roughnesses of 1 micron or finer formed by suitable known surface modification treatments and by doing so improve the resulting bonding properties of the protective or release sheet to the adhesive layer. Note also that JP Abstract -164 is clearly believed to teach the rubber-like organic elastic layer set forth in applicants' claims 4 and 5.

With respect to applicants' arguments that the data set forth in the specification in the Table at page 31 establishes unexpected results, the Examiner again must respectfully disagree. Applicants' specification on page 29 discussing what is the only Comparative Example in the case appears to state that it is substantially identical, i.e. "same procedure as in Example 1" to at least Example 1 except for the absence of a conductive powder (PASPRAN 5110S). Thus, the adhesive properties of the two examples would be expected to be about the same, and in fact the Table results appear to indicate that the Comparative Example was both slightly rougher, and also had a slightly greater adhesive force before heating. However, as to the inferior antistatic properties previously referred to the Examiner believes that such would clearly be expected from the absence of the conductive powder in the Comparative Example.

4. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C.F.R.

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§ 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-0994.

Dzirker:cdc

January 28, 2004

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1900~~
1700

Daniel Zinker